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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,882	09/19/2001	Wilhelm Ernst Riedl	PTU 000001	9853

7590 09/30/2004  
JOSEPH S. TRIPOLI  
THOMSON MULTIMEDIA LICENSING INC.  
2 INDEPENDENCE WAY  
P.O. BOX 5312  
PRINCETON, NJ 08543-5312

EXAMINER

PEREZ GUTIERREZ, RAFAEL

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/955,882	Riedl et al.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Rafael Perez-Gutierrez	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 September 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>09/19/2001</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 2686

### DETAILED ACTION

#### *Priority*

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

If applicant desires priority under 35 U.S.C. 119(e) based upon a previously filed provisional application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph.

#### *Information Disclosure Statement*

2. The information disclosure statement submitted on September 19, 2001 has been considered by the Examiner and made of record in the application file.

#### *Drawings*

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference number "108" has been used to designate both the **cordless handset** and the **antenna**

Art Unit: 2686

on **figure 2**.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference number mentioned in the description on **page 5 line 20**:

On **figure 2**, reference number **206** identifying the transceiver circuitry is not shown.

5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office Action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended”. If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the Examiner, the Applicant will be notified and informed of any required corrective action in the next Office Action. If a response to the present Office Action fails to include proper drawing corrections, corrected drawings or arguments therefor, the response can be held **NON-RESPONSIVE** and/or the application could be **ABANDONED** since the objections/corrections to the drawings are no longer held in

Art Unit: 2686

abeyance.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless -- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-25** are rejected under 35 U.S.C. 102(b) as being anticipated by **Hotto (U.S. Patent # 5,410,541)**.

Consider **claim 1**, Hotto clearly discloses a method of simultaneously communicating voice and data in a cellular (cordless) telephone system (column 5 lines 46-53), the method comprising the acts of:

generating an analog signal from an audible voice signal during a cellular (cordless) telephone call (abstract and column 3 lines 27-40);

generating a digitally modulated signal from digital data during the cellular (cordless) telephone call (abstract and column 3 lines 41-60);

summing the analog signal and the digitally modulated signal to produce a composite analog and digital signal (abstract and column 3 lines 45-47 and 60-64);

modulating a radio frequency (RF) carrier with the composite analog and digital signal to produce a modulated RF carrier (column 5 lines 53-63); and

transmitting the modulated RF carrier (column 5 lines 53-63).

Art Unit: 2686

Consider **claims 2 and 3**, and **as applied to claim 1 above**, Hotto further discloses that the digital data comprise caller identification (ID) data (text message data) for visual display (column 1 lines 15-30 and column 3 lines 41-60).

Consider **claim 4**, and **as applied to claim 1 above**, Hotto also discloses that the act of generating the digitally modulated signal comprises generating a frequency shift keying (FSK) signal (column 3 lines 53-58).

Consider **claim 5**, and **as applied to claim 1 above**, Hotto further discloses that the act of generating the analog signal comprises generating an analog signal having frequencies within the range 500-5,000 Hz and the act of generating the digitally modulated signal comprises generating a digital signal having a nominal frequency within the range 10-30 KHz (column 5 lines 29-42).

Consider **claim 6**, Hotto also discloses a method of simultaneously communicating voice and data in a cellular (cordless) telephone system (column 5 lines 46-53), the method comprising the acts of:

receiving a modulated radio frequency (RF) carrier during a cellular (cordless) telephone call (column 3 lines 1-4, column 4 lines 43-59, and column 5 lines 53-63);

demodulating the modulated RF carrier to produce a composite analog and digital signal (column 4 lines 43-59 and column 5 lines 53-63);

filtering the composite analog and digital signal to separate an analog signal and a digitally modulated signal from one another (column 5 lines 1-13);

producing an audible voice signal from the analog signal (column 4 line 39 - column 5

Art Unit: 2686

line 28); and

detecting digital data from the digitally modulated signal and processing the digital data for display or control in the cellular (cordless) telephone system (column 1 lines 15-30 and column 4 line 39 - column 5 line 28).

Consider **claims 7 and 8**, and **as applied to claim 6 above**, Hotto further discloses that the digital data comprise caller identification (ID) data (text message data) for visual display (column 1 lines 15-30, column 3 lines 41-60, and column 4 lines 12-38).

Consider **claim 9**, and **as applied to claim 6 above**, Hotto also discloses that the act of detecting digital data comprises detecting digital data from a frequency shift keying (FSK) signal (column 3 lines 53-58 and column 5 lines 1-13).

Consider **claim 10**, and **as applied to claim 6 above**, Hotto further discloses that the analog signal has frequencies within the range 500-5,000 Hz and the digitally modulated signal has a nominal frequency within the range 10-30 KHz (column 5 lines 29-42).

Consider **claims 11-13 and 16**, Hotto also discloses a cellular (cordless) telephone device (e.g., cellular (cordless) telephone instrument (unit) or cellular (cordless) telephone switching facility (base station)) (figure 1, column 3 line 20 - column 4 line 11, and column 5 lines 45-53), comprising:

an audio circuit (not shown) which produces an analog signal from an audible voice signal during a cellular (cordless) telephone call (column 3 lines 24-40);

a first modulator (e.g., a frequency shift keying (FSK) modulator producing an FSK signal) which modulates a carrier with digital data to produce a digitally modulated signal

Art Unit: 2686

(column 3 lines 53-60);

an adder 10 (summer circuit) which sums the analog signal and the digitally modulated signal to produce a composite analog and digital signal (figure 1 and column 3 lines 45-47 and 60-66);

a second modulator (e.g., means for imposing) which modulates a radio frequency (RF) carrier with the composite analog and digital signal to produce a modulated RF carrier (column 5 lines 53-63); and

a transmitter (e.g., means for imposing and transmitting) which transmits the modulated RF carrier (column 5 lines 53-63).

Consider **claims 14 and 15**, and **as applied to claim 11 above**, Hotto further discloses that the digital data comprise caller identification (ID) data (text message data) for visual display (column 1 lines 15-30, column 3 lines 41-60, and column 4 lines 12-38).

Consider **claim 17**, and **as applied to claim 11 above**, Hotto also discloses that the audio circuit (not shown) produces an analog signal having frequencies within the range 500-5,000 Hz and the first modulator (e.g., FSK modulator produces a digitally modulated signal having a nominal frequency within the range 10-30 KHz (column 3 lines 53-60 and column 5 lines 29-42).

Consider **claims 18-20 and 23**, Hotto further discloses a cellular (cordless) telephone device (e.g., cellular (cordless) telephone instrument (unit) or cellular (cordless) telephone switching facility (base station)) (figures 1 and 2, column 4 line 12 - column 5 line 13, and column 5 lines 45-53), comprising:



Art Unit: 2686

means for receiving (receiver) which receives a modulated radio frequency (RF) carrier during a cellular (cordless) telephone call (column 5 lines 53-63);

means for detecting (demodulator which demodulates) the modulated RF carrier to produce a composite analog and digital signal (column 5 lines 53-63);

a filter 14 which filters the composite analog and digital signal to separate an analog signal and a digitally modulated signal from one another (figure 2, column 4 lines 17-25 and 59-65, and column 5 lines 1-13);

a speech network 16 (audio circuit with speaker) which produces an audible voice signal from the analog signal (figure 2 and column 4 lines 17-21);

an analog interface 20 (detector) which detects digital data from the digitally modulated signal that comprises a frequency shift keying (FSK) signal (figure 2, column 3 lines 53-60, and column 4 lines 43-59); and

a digital signal processor (DSP) 22 which processes the digital data for display or control in the cellular (cordless) telephone device (figure 2 and column 4 lines 39-65);

wherein the speech network 16 (audio circuit with speaker) remains unmuted during receipt of the digital data (column 2 lines 18-27).

Consider **claims 21 and 22**, and **as applied to claim 18 above**, Hotto also discloses that the digital data comprise caller identification (ID) data (text message data) for visual display (column 1 lines 15-30, column 3 lines 41-60, and column 4 lines 12-38).

Consider **claim 24**, and **as applied to claim 18 above**, Hotto further discloses that the analog signal has frequencies within the range 500-5,000 Hz and the digital signal has a nominal

Art Unit: 2686

frequency within the range 10-30 KHz (column 5 lines 29-42).

**Claim 25** is similarly rejected for the same reasons explained in detail above for **claims 11, 12, 14-16, 18, 19, and 21-23.**

***Conclusion***

7. Any response to this Office Action should be **faxed to (703) 872-9306 or mailed to:**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Hand-delivered responses** should be brought to

220 S. 20<sup>th</sup> St.  
Crystal Plaza Two, Lobby, Room 1B03  
Arlington, VA 22202

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rafael Perez-Gutierrez whose telephone number is (703) 308-8996. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

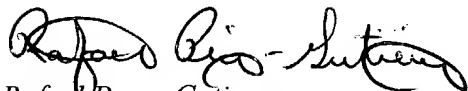
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (703) 305-4379. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent

Art Unit: 2686

Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700 or call customer service at (703) 306-0377.



*Rafael Perez-Gutierrez*

R.P.G./rpg **RAFAEL PEREZ-GUTIERREZ**  
**PATENT EXAMINER**

September 23, 2004